

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Dieter DORSCH : Group Art Unit.: 1626
Serial No.: 10/525,001 : Examiner: STOCKTON, Laura Lynne
Filed: February 17, 2005 :
Title: BENZIMIDAZOLE DERIVATIVES

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In response to the Office Action mailed on February 28, 2008, applicants elect with traverse the first compound of claim 30, which is disclosed in example 3, which is 2-[2-(5-chlorothiophen-2-yl)-1*H*-benzimidazol-5-yl]-*N*-[4-(3-oxomorpholin-4-yl)phenyl]acetamide. The definition of the various substituents are as follows: D is thiophenyl substituted by Chlorine, R¹ is hydrogen, X, X' are hydrogen, W is acetamide, Y is phenylene, T is 3-oxomorpholin-4-yl.

The traversal is on the basis that the Office Action has not established that it would pose an undue search burden to Examine the full scope of the claims.

In accordance with M.P.E.P. 803.02, the Examiner is reminded that, should no prior art be found which renders the invention of the elected species unpatentable, the search of the remainder of the generic claim(s) should be continued in the same application. Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. See MPEP 803.02 in accord.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

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